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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,271	06/20/2003	Grégory R. Ley	279.603US1	6442

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EXAMINER
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BOCKELMAN, MARK

ART UNIT	PAPER NUMBER
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3766

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/601,271

**Applicant(s)**

LEY ET AL.

**Examiner**

Mark W. Bockelman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 22-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-17, 22-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claim 29 states that the "tunneling" rod has a cone shaped tip and dependent on claim 11 states that the tunneling member rod has a holding member allowing the device to be pulled there through. Clearly in the original specification shows that the tunneling rod is not taught as having a cone shaped tip but rather instead has apparenthas a distal tunneling tip attachable thereto by what appears to be screw threads. The holding element and the tip are mutually exclusive members.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13-15, 17-24 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fogarty et al USPN 5,690,648 (alone or in view of Thomason et al. USPN 6,183,485).

Fogarty shows a forceps device having a portion 26 that would inherently include a rod (or between 26 and the finger holes for a handle (s)) and a grasping distal end for grasping a tail of an electrode for pulling it through outer tube 20 (column 6 lines 31-41). While teaching an insertion method it is apparent that the electrode be removed by grasping the electrode with the forceps already inserted in the tube and pulling back so as to pull the electrode through the tube. Flexible and rigid are relative terms and the trocar tube 20 can be considered either depending upon what it is compared too. In the inserted state, the electrode diameter is smaller than the tube diameter. As noted above, while the portion 26 does not necessary show a rod, the examiner considers it inherent to forceps structures and otherwise relies upon Thomson et al USPN 6,183,485 as having forceps comprising rods and detachable grasping members. Since applicant uses the transition phrase "comprising", the examiner considers multiple rods to meet the recitation of "a rod", and considers the adjective "tunneling" to be a statement of intended use. The examiner notes that applicant's rod requires the attachment of a tunneling tip member for tunneling and when attached, does not permit the rod to move in the tube or allow for holding. The cited references meet the same structure. The examiner considers the forcep members in each of the Fogarty and Thomason references to have conical tunneling tips since forcep members are generally tapered and blunt and they are capable of being pushed through tissues.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty et al USPN 5,690,648 in view of Thomason et al. USPN 6,183,485. Applicant differs from Fogarty et al. in providing detachable holding means which is a common

construction for forceps which are typically held together by pins. The mere making an element in a known device is considered an obvious modification and especially in light of the showing by Thomason

Claims 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty et al USPN 5,690,648 (alone or in view of Thomason et al. USPN 6,183,485) and further in view of Fleischhacker USPN 4,596,559. Applicant differs from Fogarty in providing a peelable introducer tube. Using a peelable introducer tube to aid in inserting instruments in the body would have been obvious in view of the teachings of Fleischhacker.

### ***Response to Arguments***

Applicant's arguments filed 8-7-2006 have been fully considered but they are not persuasive. In regard to claim 11, the applicant argues that the Fogarty reference does not have a "tunneling" rod. Besides the fact that this is merely a statement of intended use with no given structural distinction, the applicant's "tunneling" rod does not actually act as a tunneling rod when the holding member, that is positively recited in the claim is removed from the end of the rod and the tunneling tip is attached. Thus applicants "tunneling" rod is merely a rod, to which end attachments may be secured. The Fogarty and Thomason references are interpreted the same as the applicant's specification. Concerning claim 22, the examiner reasserts that the Fogarty device is capable of having the electrode pulled through the tube from either end. Applicant has provided no evidence that the Fogarty device would not be capable of performing the task, but rather states that the task is not taught. The examiner reminds applicant that claim 22 is

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an apparatus claim and not a method claim, and therefore his arguments need to address the structural differences and not the intended method of using the device. The examiner repeats that the Fogarty device would be capable of having the electrode gripped by the forceps end extending out of the tube and pulling the electrode back through the tube.

***Allowable Subject Matter***

Claims 1-10 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.

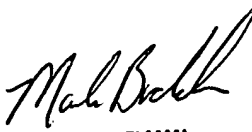
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWB

August 29, 2006

  
MARK BOCKELMAN  
PRIMARY EXAMINER